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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS R. GOECKE

Appeal 2008-4501
Application 10/674,108
Technology Center 1700

Decided:¹ February 19, 2009

Before CATHERINE Q. TIMM, LINDA M. GAUDETTE, and
KAREN M. HASTINGS, *Administrative Patent Judges*.

GAUDETTE, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-7 and 9-12, the only claims pending in the Application. (Appeal Brief, filed March 19, 2007, (“Br.”) 4 § III.) We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

Claim 1 is illustrative of the invention and is reproduced below:

1. An adhesive tape comprising:

a polymer layer having a Shore A Hardness of between about 92 and 100 and a substantially uniform thickness of between about 0.020" to 0.065"; and

a layer of adhesive attached to said polymer layer.

The Examiner relies on the following prior art references to show unpatentability (Examiner's Answer, mailed September 18, 2007, ("Ans.") 3 § (8)):

Oace	US 2,559,990	Jul. 10, 1951
Guenther	US 6,461,751 B1	Oct. 8, 2002
Hughart	US 6,668,504 B2	Dec. 30, 2003

Appellant requests review of the following grounds of rejection (Br. 5 § VI.):

1. claims 1-6 and 9-10 under 35 U.S.C. § 103(a) as unpatentable over Oace in view of Hughart;

2. claim 12 under 35 U.S.C. § 103(a) as unpatentable over Oace in view of Guenther; and

3. claims 7, 10, and 11 under 35 U.S.C. § 103(a) as unpatentable over Oace in view of Hughart and Guenther (*see* Ans. 2, § (5) (correcting Appellant's statement of the grounds of rejection)).

ISSUE

Has Appellant shown that the Examiner reversibly erred in determining that it would have been obvious to one of ordinary skill in the

art at the time of the invention to have combined the applied prior art in the manner claimed?

We answer this question in the negative as to each ground of rejection for essentially the reasons stated in the Examiner's Answer, which we explain in further detail below.

FINDINGS OF FACT

1. The present invention relates to an adhesive tape which is said to have superior ductility, strength, tear resistance, and abrasion resistance. (Spec. 1:7-8.) The tape is for use, for example, as floor marking in industrial and factory environments. (Spec. 1:10-11.) According to the Specification, a disadvantage of prior art tapes is that they "lack[] sufficient strength and hardness to prevent wearing, tearing, cracking and breakage from heavy and repeated traffic." (Spec. 1:11-13.) Another disadvantage is that they have poor adhesive quality, and tend to detach from repeated traffic (e.g., forklift trucks). (Spec. 1:14-15.)
2. Oace claims "[a] pressure-sensitive adhesive insulating tape . . . comprised of: a stretchable and elastic film backing having a thickness of 4 to 20 mils and formed of a homogeneous mixture primarily consisting of a stable blend of a film-forming polymer of monomers including at least a major proportion of vinyl chloride. . . ; and a . . . pressure-sensitive rubber-resin type adhesive coating united to the inner face of said film backing." (Oace, claim 1.)
3. Hughart discloses the use of elastomeric strips for fastening a wall panel to wall studs, thereby providing a sound-deadened wall. (*See*

- Hughart, claim 1.) The elastomeric strips may be made “of an elastomeric polymer, such as polyvinyl chloride having a hardness of Durometer 92 Shore A.” (Hughart, col. 2, ll. 42-43.) According to Hughart, “[a]ny suitable adhesive” may be used to adhere the elastomeric strips to the wall panels. (Hughart, col. 2, ll. 43-45.)
4. Guenther discloses a closure tape for an absorbent article comprising an essentially non-elastic backing material (Abstract) having a thickness of 50-500 μm and made from a polymer material such as polyvinyl chloride (col. 7, ll. 19-25). According to Guenther, the backing material bears an adhesive layer (col. 7, l. 27) which is preferably a pressure-sensitive adhesive, such as a rubber based adhesive (col. 8, ll. 37-38), exhibiting a 90° peel adhesion from a polyethylene surface of at least 3.5 N/cm (col. 8, ll. 11-16). The pressure-sensitive adhesive preferably exhibits a high value of static shear so that the tape does not inadvertently loosen. (*See* Guenther, col. 8, ll. 22-29.) The thickness of the adhesive layer is preferably between 20 and 100 μm . (Guenther, col. 8, ll. 50-52 and 63-65; col. 9, l. 66-col. 10, l. 1.)
5. Guenther discloses that “the adhesion behavior of the adhesive . . . with respect to the target area \square is governed both by the nature of the adhesive and the surface properties of the target area” (col. 10, ll. 25-28). According to Guenther, “[w]hen using an appropriate release surface . . . it is often possible to use aggressive pressure-sensitive adhesives. . . . Alternatively, the pressure-sensitive adhesive . . . may be partially detackified to render it less aggressive and removable from the target area” (col. 10, ll. 36-43).

Rejection of claims 1-6 and 9-10 under 35 U.S.C. § 103(a) as unpatentable over Oace in view of Hughart:

6. The Examiner relies on Oace for a disclosure of the invention as claimed in independent claim 1, with the exception of an express teaching that the backing film has a Shore A Hardness of 92-100.

The Examiner contends that

it would have been obvious to one having ordinary skill in the art to utilize Hughart's teaching of providing an adhesive tape backing of polyvinyl chloride having a Shore A Hardness of 92 in the invention of Oace with the motivation to provide for hardness imparted for structural strength to the tape.

(Ans. 3.)

7. Appellant does not dispute that Hughart discloses a polymer layer having the Shore A hardness recited in claim 1. (*See* Br. 8-9.) Nor does Appellant dispute the Examiner's contention that it would have been a matter of routine optimization to achieve a Shore A Hardness of 93-97, as recited in dependent claim 9 (Ans. 4). (*See* App. Br. 10.) However, Appellant argues that "as a whole, Hughart does not fairly suggest a polymer layer having the Shore A Hardness limitation missing from Oace" (Br. 8; *see also*, Br. 10 (relying on the same arguments in traversing the rejections of claims 5, 6, and 9)), because Hughart's elastomeric strips are "not an adhesive tape but instead a 'spacer' that is adapted to provide air gaps between the studs and the wall panel" (Br. 9). Appellants further argue that Hughart's elastomeric strips "appear to be about the thickness of the wall board"

- which is an order of magnitude greater than Appellants' claimed thickness. (Br. 9.)
8. With respect to dependent claim 2, Appellant concedes that Hughart discloses attaching the outermost side of the elastomeric strips to a wall panel. (App. Br. 9.) Appellant disputes the Examiner's contention that the "substrate" of appealed claim 2 reads on Hughart's wall panel (Ans. 3). (App. Br. 9.)
9. With respect to dependent claim 3, the Examiner finds that, in order to bond to the adhesive layer, Oace's backing would inherently possess the claim 3 "textured surface." (Ans. 4.) The Examiner also finds that Hughart's elastomeric strips include holes which provide a textured surface as claimed. (Ans. 7.) Appellant argues that "[t]here is no teaching of a 'textured surface' in either Oace or Hughart." (Br. 9.)

Rejection of claim 12 under 35 U.S.C. § 103(a) as unpatentable over Oace in view of Guenther and rejection of claims 7, 10, and 11 under 35 U.S.C. § 103(a) as unpatentable over Oace in view of Hughart and Guenther:

10. The Examiner maintains that Oace, as modified by Hughart, discloses the invention as claimed in independent claim 11 with the exception that the adhesive is a rubberized double-sided tape. (Ans. 6.) The Examiner contends that "it would have been obvious to one having ordinary skill in the art to utilize Guenther's teaching of using a double-sided rubberized pressure sensitive adhesive tape in the invention of Oace with the motivation to provide for enhancing its peel adhesion characteristics." (Ans. 6.)

11. The Examiner relies on Oace for a disclosure of the invention as claimed in independent claim 12, with the exception of an express teaching that the adhesive layer has a peel adhesion of greater than 2.0 lb/in width. (Ans. 5.) The Examiner contends that one of ordinary skill in the art would have been motivated to provide Oace's adhesive layer with a peel adhesion of at least 3.5 N/cm (which includes Appellant's claimed range) based on the advantages disclosed by Guenther.
12. Appellant does not refute the Examiner's findings with respect to the teachings of Guenther. (*See* Br. 10-12.) Rather, Appellant contends that the Examiner's proposed motivation for combining the applied prior art is based on improper hindsight reasoning. (Br. 10 and 11.) Appellant points out that Guenther's backing layer is non-elastic and rendered stretchable by incisions (or slits). (Br. 10.) Appellant contends that use of this layer in Oace's tape "would seriously undermine" the desired elastic and insulating properties of Oace's tape. (Br. 11.)
13. Appellant further argues that the thickness of Guenther's polymer layer, which Appellant calculates as a maximum of "0.019685 inches" (Br. 11 n.1), is less than the range of "between 0.020 and 0.065" required by claims 7, 10, and 12 (Br. 11-12).

PRINCIPLES OF LAW

In making a patentability determination, analysis must begin with the question, "what is the invention claimed?" since "[c]laim interpretation, . . . will normally control the remainder of the decisional process." *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567-68 (Fed. Cir. 1987); *see*

also, In re Self, 671 F.2d 1344, 1348 (CCPA 1982) (“Many of appellant’s arguments fail from the outset because, . . . they are not based on limitations appearing in the claims.”).

During examination, claims terms “must be given their broadest reasonable construction consistent with the specification.” *In re Icon Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007).

Two factors are considered in determining whether prior art is analogous: “(1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor’s endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.” *In re Clay*, 966 F.2d 656, 658-59 (Fed. Cir. 1992) (citations omitted). “Whether a reference in the prior art is ‘analogous’ is a fact question.” *Id.* at 658. A reference is considered analogous art if “even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.” *Id.* at 659; *see also, KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, ---, 127 S. Ct. 1727, 1742 (2007) (“[F]amiliar items may have obvious uses beyond their primary purposes.”); *In re Paulsen*, 30 F.3d 1475, 1481-82 (Fed. Cir. 1994) (determining that housings, hinges, latches, and springs found in items like a piano lid and kitchen cabinet were reasonably pertinent to the development of a latch system for personal computers); *Icon*, 496 F.3d at 1379-80 (determining that springs used in a folding bed were reasonably pertinent to an inventor developing a treadmill with a folding mechanism).

When “the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product.” *In re Best*, 562 F.2d 1252, 1255-56 (CCPA 1977); *see also In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990) (“[W]hen the PTO shows sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.”).

ANALYSIS

Appellant first argues that Oace and Hughart are non-analogous art because they relate to insulation and protection of electrical conductors and to spacers separating wall boards from underlying wood studs. (Br. 8.) Contrary to Appellant’s contention, we find that the Examiner properly applied these references in rejecting the appealed claims since they are “reasonably pertinent to the particular problem with which the inventor is involved,” *Clay, supra*. In particular, both references are concerned with maintaining adherence of a tape to a substrate under conditions in which the tape may be subjected to forces or environmental conditions which reduce the adhesive properties of a pressure sensitive adhesive.

With respect to Appellant’s remaining arguments, we are not persuaded of reversible error on the part of the Examiner because Appellant (1) has not addressed the facts and reasons relied on by the Examiner in rejecting the claims and (2) relies on unclaimed features to distinguish over the applied prior art.

With respect to Appellant’s failure to address the Examiner’s contentions, we note that Appellant’s arguments focus on the differences

between the claimed polymer layer and either Hughart's or Guenther's backing materials. For example, Appellant contends that substitution of Hughart's backing material for Oace's backing would not result in a polymer layer having the claimed thickness. However, the Examiner's rejections are not based on a determination that it would have been obvious to have substituted Oace's backing with Hughart's or Guenther's backing materials per se. Rather, the Examiner's rejection is based on a determination that it would have been obvious to have *modified* Oace's backing in view of Hughart or Guenther. Because Appellant did not address the Examiner's rationale for rejecting the claims, Appellant has not shown that the Examiner reversibly erred.

With respect to claim 3, we note that Oace's disclosure of a polymeric backing having an adhesive secured thereto, the same structural elements claimed by Appellant, gave the Examiner reason to believe that Oace's backing would inherently possess a textured surface as claimed in appealed claim 3. Appellant thus had the burden to establish the contrary, but did not provide evidence to refute the Examiner's finding.

Appellant also argues that several inventive features are not disclosed or suggested by the Examiner's proposed combination of references. However, Appellant has not identified reversible error in the Examiner's determination that the claims, as drafted, do not recite these argued features. For example, Appellant has not identified any language in the Specification or claims which warrants a narrow interpretation of the claim 2 term "substrate" as excluding Hughart's wall board.

CONCLUSION

Appellant has not identified reversible error in the Examiner's obviousness determination. The decision of the Examiner rejecting claims 1-7 and 9-12 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

PL Initial:
sld

BENESCH, FRIEDLANDER, COPLAN
& ARONOFF LLP
ATTN: IP DEPARTMENT DOCKET CLERK
2300 BP TOWER
200 PUBLIC SQUARE
CLEVELAND, OH 44114